Applicant : Brian K. Doyle et al.
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REMARKS

Claims 1, 2, 5, 7-8, 11-12, 14-17, 19-20, 22-27, 29-33, 35-41, 43, 45-48, 50-51, 53-55, 57, 59 and 60 are pending in the present application. Applicants' Petition for a one-month extension of time has been simultaneously filed along with this Response. Reconsideration of the amended claims is respectfully requested for the reasons discussed below.

In the non-final rejection mailed December 15, 2005, the Examiner rejected claims 1-2, 5-7, 11-12, 14-17, 19-20, 22-27, 29-33, 35-41, 43, 45-48, 50-51, 53-55, 57 and 59-60 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement.

Applicants respectfully submit that the Examiner has not met her burden of proving that Applicants have failed to comply with the written description requirement. The Examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an Applicant's disclosure a description of the invention defined by the claims. *In re Wertheim*, 541 F.2d 257, 263 (CCPA 1976). Applicants respectfully assert that "flour" was described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants submit that the limitation to "flour" was supported by the abstract of the originally filed application, which stated:

> A new type of food product made from shapeable, shape-retaining dough whose principle ingredient may be potato or essentially any grain-based flour or the like. The dough is shaped, coated with a batter/slurry made from flour or starch and water plus desired seasoning, coloring, etc., and then cooked, or parfried and frozen for subsequent reconstitution (finish-cooking) in a toaster, gradient oven, microwave oven, grill, broiler or the like. The finished product has a crispy/crunchy exterior and a light, fluffy interior, with many variations made possible by different dough types, etc. One particular embodiment is a potato waffle which is reconstitutable in a domestic toaster and has a soft, moist interior and crispy exterior.

Accordingly, in view of the amendment to the specification and the original abstract, Applicants submit that the pending claims satisfy the written description requirement and respectfully request the Examiner to withdraw this rejection.

The Examiner has also rejected claims 1-2, 5, 7-8, 11-12, 14-17, 19-20, 22-27, 29-33, 35-41, 43, 45-48, 50-51, 53-55, 57 and 59-60 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,109,024 to Cremer in view of U.S. Patent No. 5,928,693 to Friedman et al. and U.S. Patent No. 5,976,607 to Higgins et al. The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. To establish a prima facie case of obviousness, the Examiner must prove that (1) there must be some suggestion or motivation either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, (2) there must be a reasonable expectation of success, and (3) the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP § 2142.

Applicants respectfully submit that the Examiner has not established a *prima facie* case of obviousness since she has not shown that there would be a suggestion or motivation to modify any reference or combine the reference teachings. The Examiner stated that "[i]t would have been obvious to coat the Cremer potato product with the clear coating disclosed by Friedman et al. for the advantage disclosed by Friedman et al." Applicants respectfully submit that the Examiner's statement is simply conclusory and does not make any specific factual findings as to why one having ordinary skill in the art would have combined these teachings to obtain the claimed invention. See *In re Lee*, 277 F.3d 1338, 1342-44 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references).

Even assuming that the Examiner's statements were not conclusory, Applicants assert that there would be no motivation to combine the Cremer potato product with the Friedman et al. coating. The '024 patent to Cremer actually teaches away from applying a coating to the dough of the '024 patent to Cremer. A reference is said to teach away when "a person of ordinary skill in the art, upon reading the reference, would be discouraged from following the

path set out in the reference or would be led in a direction divergent from the path that was taken by the Applicant." *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994). The Federal Circuit in *Gurley* went on to say that a reference which teaches away cannot be the basis of a *prima facie* obvious rejection. *Id.*

The '024 patent to Cremer teaches away from applying a starch component to the outside of a potato dough. In particular, Cremer states:

> The formed product is placed in hot oil which is at a temperature in excess of 250° F. to make sure that the amylose component is gelatinized and preferably at a temperature in excess of 350° F. The optimum is 375° to 400° F. The temperature and time should be sufficient to cause the amylose starch component to form the "film" and prevent undue imbibition of oil. The potato product is fried until it is browned and then it is removed from the hot oil.

(Cremer, col. 5, lines 58-66). The stated purpose of incorporating the amylose starch component into the dough is to form a "film." The Cremer reference also states that:

> In addition, the starch binder of this invention imparts to the potato product improved stability in dry storage. The reasons for this are not now understood. A further advantage of the present binder is that the handling properties of the formed potato piece are better, that is, they have greater mechanical strength and can be handled with less breakage between the formation of the potato piece and frying.

(Cremer, col. 2, lines 35-42). The reference clearly states that the binder provides the advantages of adding "greater mechanical strength" and "less breakage." As such, there would be no motivation to add a coating such as Friedman for the purpose cited by the Examiner, presumably to improve crispness.

Moreover, one would not have been motivated to combine Cremer with Friedman because a stated objective of Cremer was to provide a potato product "which imbibes little frying oil." (Cremer, col. 2, lines 5-10). In actuality, when a clear coat composition is applied to a french fry potato product and that coated product is subsequently fried, the coating typically imbibes frying oil thereby increasing its fat content. (*See* U.S. Patent Application

Publication No. 2004/0146630 A1 at paragraph [0003]). Because the stated objectives of Cremer include imbibing little frying oil, it would be contrary to this objective to add the french fry coating of Friedman. As such, for this additional reason, Applicants respectfully submit that one of ordinary skill in the art would not have been motivated to combine the coating of Friedman and the Cremer potato product.

Applicants also respectfully submit that the Examiner has not shown that there would be a reasonable expectation of success in combining the Cremer potato product with the Friedman et al. coating. There is no indication in any of these references of how the dough and the resultant film formed in the Cremer product would chemically interact with the coating disclosed by Friedman et al. Therefore, one having ordinary skill in the art would not have a reasonable expectation that the coating would be successful if it was applied to the Cremer potato product.

The Examiner also stated that "it would have been obvious to add modified potato starch as taught by Higgins et al. to the Friedman et al. coating when it is desired to adjust the crunchy texture of the coating." Applicants respectfully submit that Examiner has impermissibly decided to pick and choose only so much of the Higgins et al. reference that will support the Examiner's position. *In re Hedges*, 783 F.2d 1038, 1041 (Fed. Cir. 1986); see also *Ex parte Philippe-Guilhaume Gottis*, Appeal No. 2001-0008, 2002 WL 31234500 (Bd. Pat. App. & Inter.). Applicants respectfully submit that, when the cited references are considered as a whole, there is no motivation to combine the modified potato starch as taught by Higgins et al. into the Friedman et al. coating. In fact, the Higgins et al. reference teaches away from combining these references to obtain the claimed invention for the following reasons.

The Higgins et al. reference does not teach how one having ordinary skill in the art should add the unmodified potato starch into the Friedman et al. coating. For example, which component should the unmodified potato starch be substituted for? In what amounts should the unmodified potato starch be substituted? Applicants submit that the Examiner's assumptions in

how one having ordinary skill would have answered these questions result from picking and choosing from various references to obtain the claimed invention.

Furthermore, Applicants assert that, specifically for claims 1-2, 5, 7-8, 11-12, 14-17, 19-20, 22-27, 29-33, 35-41, 45-46, 48, 50-51, 53-55 and 57 which require a "substantially clear coating," the Examiner has not carried her burden to show that it would have been obvious to combine the Higgins et al. modified potato starch into the Friedman et al. coating. The Examiner did not consider the Higgins et al. reference as a whole since the Examiner essentially disregards the disclosure in the reference, which states that "[i]n some coatings, *especially when the clearness of the coating is not important*, it is advantageous to include in the coating a substantial amount of modified potato starch." (Higgins et al., col. 6, lines 40-42 (emphasis added)). Applicants assert that the statement from the Higgins et al. reference implies that modified potato starch will affect the clearness of the coating. Therefore, one having ordinary skill in the art would not have been motivated to use this component to create the claimed invention, namely a coating that would be "substantially clear."

Accordingly, Applicants respectfully submit that the Examiner has not established a *prima facie* case of obviousness in view of the cited references. The Applicants have made an effort to place the present application in condition for allowance, and a notice to this effect is earnestly solicited. In the event there are any remaining formalities or other issues needing Applicants' assistance, Applicants respectfully request the Examiner to call the undersigned attorney.

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Respectfully submitted,

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